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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,546	06/24/2005	Hideaki Matsuoka	274130US0PCT	1053
22850	7590	05/21/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHOWDHURY, IQBAL HOSSAIN	
			ART UNIT 1652	PAPER NUMBER
			NOTIFICATION DATE 05/21/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/540,546

Applicant(s)

MATSUOKA ET AL.

Examiner

Iqbal H. Chowdhury, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

This application is a 371 of PCT/JP03/16895.

Claims 1-19 are currently pending.

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group, I claim(s) 1, 2, drawn to an agent for inhibiting IL-2 production and/or immunocyte proliferation having low GATA-1 producing activity comprising a selective HDAC4 and/or HDAC8 inhibitor.

Group, II claim(s) 3-12, drawn to a method of identifying an IL-2 production inhibitor and/or immunocyte proliferation inhibitor, which comprises measuring the HDAC4 and/or HDAC8 inhibitory activity.

Group, III Group, 13, 15, drawn to a kit for identification of an immunosuppressant having low thrombocytopenic activity, comprising a HDAC4 and/or HDAC8.

Group, IV claim(s) 14, drawn to a DNA molecule having the amino acid sequence of SEQ ID NO: 4; wherein said amino acid sequence is HDAC4 variant.

Group, V claim(s) claims 14, drawn to a DNA molecule having the amino acid sequence of SEQ ID NO: 6, wherein said amino acid sequence is HDAC4 variant.

Art Unit: 1652

Group, VI claims 16 and 17, drawn to a method of inhibiting IL-2 production and/or immunocyte proliferation having low GATA-1 producing activity comprises administering an effective amount of selective HDAC4 and/or HDAC8 inhibitor to a subject.

Group, VII claims 18 and 19, drawn to a method of production of an agent for inhibiting IL-2 production having low GATA-1 producing activity by using selective HDAC4 and/or HDAC8 inhibitor.

2. The inventions listed as Groups I - VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The DNA encoding a polypeptide HDAC4 of Group IV and V, an agent for inhibiting IL-2 production and/or immunocyte proliferation, comprising a selective HDAC4 and/or HDAC8 inhibitor of Group I, and kit of Group II are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to a wildtype and mutant polypeptide HDAC4. However, this shared technical feature is not a "special technical feature" as defined by PCT Rule 13.2 as it does not define a contribution over the art. Wang et al. teach a polypeptide of human HDAC4 and several mutants, having histone deacetylase activity, which is known in the art (Wang et al. "HDAC4, a human histone deacetylase related to yeast HDA1, is a transcriptional corepressor, Mol Cell Biol. 1999 Nov;19(11):7816-27, see IDS). Thus, a HDAC4 polypeptide and its use does not make contribution over the prior art.

3. A method of identifying IL-2 production inhibitor of Group II does not share any "special technical feature" with Group IV and V as the polynucleotides of Group IV and V are neither made nor used by the method of identifying IL-2 production inhibitor of Group II.

Art Unit: 1652

4. A method of inhibiting IL-2 production of Group VI does not share any "special technical feature" with Group IV and V as the polynucleotide of Group IV and V are neither made nor used by the method of Group VI.

5. A method of production of an agent for inhibiting IL-2 production of Group VII does not share any "special technical feature" with Group IV and V as the polynucleotide of Group IV and V are neither made nor used by the method of Group VII.

6. The methods of Groups II, and VI-VII do not have unity of invention with each other as each methods comprises unrelated steps, use different products and produce different effects.

37 CFR 1.475 does not provide for multiple products and/or methods within a single application. Therefore, inventions of Group I - VII lack unity of invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/540,546

Page 6

Art Unit: 1652

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